

19. The method of claim 18 further comprising: the additional step of screening plant material derived from the selected plants or the harvested seed with biotechnology techniques wherein identifying with genotyping that the seed is an inbred seed.

Claims Rejections-35 USC §112

Claims 5, 10-11, 14-17 and 19 were rejected under the 2nd paragraph of §112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Concerning the use of "capable of expressing" the Examiner has asked that the language be altered to "having". The applicant has amended the claim to "comprising". However, the applicant disagrees with the Examiner's statement in the office action concerning this rejection. The applicant feels the Examiner was importing limitations into the claim that do not exist. The Examiner argues that this claim is to a mature plant and not a plant at senescence. The claim is not so limited. This claim is to a corn plant. Corn plant captures a plant. Plants have stages of growth. The claim is not only to a corn plant when it is mature and but also to a corn plant when it is young or when it is at senescence.

Thus the Examiner's statement of what is claimed is importing limitations into the claim that do not exist in the language of the claim. The "capable of expressing" language is the language that should be employed in this claim, as this language does make this claim the most accurate. In BJ Serv. Co. v. Halliburton Energy Serv., Inc. 67 U.S.P.Q.2D 1692 (Fed Cir. 2003) the court teaches that claim language may not be precise, however, this does not automatically make a claim invalid. The question is whether one of ordinary skill in the art would understand what is claimed when the claim is read in light of the specification. Clearly in this instance a breeder of maize, one of ordinary skill in the art, would know what was claimed, and would understand that a plant has stages in which different physiological and morphological characteristics would be evidenced. The applicant believes that the ordinarily skilled person would also understand

"comprising" to mean that the claim is directed to a plant which has stages at which different physiological and morphological characteristics would be evidenced.

Claims 10 and 11 have been cancelled. The applicant is submitting the correct citation of the USPQ for the caselaw cited in the previous response. *Exxon Research and Eng'g Co. v. United States*, 265 F.3d 1371, 60 U.S.P.Q.2d 1272 (Fed. Cir. 2001).

Claims 12 and 18 have been amended. Claims 13-17 and 19 have been deleted. Not because they are not enabled nor indefinite but because the protection afforded in the new claims and the amended claim 18 suggested by the Examiner is sufficiently broad to afford the protection that was sought in the cancelled claims.

Claim Rejection –35 USC§112, 1st paragraph, deposit requirement

The claims 1-20 were rejected due to the fact that the specification did not indicate that the viability would be tested at the time of deposit. The Applicant's attorney assures the office if this material is deposited the viability of the seed will be tested at the time of deposit. This should overcome the rejection to these claims

Claim Rejection –35 USC§112, 1st paragraph, enablement

Claims 12-19 were rejected as unenabled. The Examiner noted that the applicant had not submitted evidence of single gene conversion. The Applicant is supplying the issued patent of 6,188,001 showing that the prior knowledge in the art of breeding through recurrent selection. The United States Patent 6,188,001 issued Feb. 1, 2001, which was prior to the filing of this application states as follows in the background of that patent:

Recurrent selection breeding, backcrossing for example, can be used to improve an *inbred* line and a hybrid which is made using those inbreds. Backcrossing can be used to transfer a specific desirable trait from one *inbred* or source to an *inbred* that lacks that trait. This can be accomplished, for example, by first crossing a superior *inbred* (recurrent parent) to a donor *inbred* (non-recurrent parent), that carries the appropriate gene(s) for the trait in question. The progeny of this cross is then mated back to the superior recurrent parent followed by selection in the resultant progeny for the desired trait to be transferred from the non-recurrent parent. After five or more backcross generations with selection for the desired trait, the progeny will be homozygous for loci controlling the characteristic being transferred, but will be like the superior parent for essentially all other genes. The last backcross generation is then selfed to give pure breeding progeny for the gene(s) being transferred. A hybrid developed from inbreds containing the transferred gene(s) is essentially the same as a hybrid developed from the same inbreds without the transferred gene(s).

Thus recurrent selection was known prior to filing of this application. However, what was not known was the inbred of the present invention. Thus amended claim 18 is enabled and should be allowed as amended.

The amendments to the claims should remove the written description argument from this case.

The applicant's attorney has added new claims that are directed to allowable and enabled material. The applicant's attorney suggests that the method of claim 18 and the newly added claims are not lacking novelty nor are they obvious in light of the teaching of U.S. pat. 5,866,763. As taught in the April response, there are numerous traits that differ between these two inbred lines. The method of making a hybrid seed with the present invention is not taught nor is it obvious in light of the BEUNDGEN patent. The newly added claims are likewise not obvious in light of this '763 patent. The Examiner's removal of this rejection is requested.

Payment of additional claims fees

Ten new dependent claims have been added. Eleven dependent claims have been deleted. It is believed that no new claims fees are necessary. To the extent that new claims fees are needed the applicant requests that such fees be taken from Account 07-0190.

The applicant believes that the claims are now in allowable form and requests that the Examiner grant allowance to these claims



Dana Rewoldt, Reg. No. 33,762
Advanta USA, Inc.
2369 330th Street, Box 500
Slater, IA 50244
(515) 685-5201

This amendment after final and one month extension of time are being faxed to the after final fax number of 1-703-872-9307 on November 7, 2003 by

Dana Rewoldt

